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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,838

02/02/2005

Daniel W. Chan

56792(71699)

1171

49383

7590

12/31/2009

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EXAMINER

HARRIS, ALANA M

ART UNIT

PAPER NUMBER

1643

MAIL DATE

DELIVERY MODE

12/31/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,838	<b>Applicant(s)</b> CHAN ET AL.	
	<b>Examiner</b> Alana M. Harris, Ph.D.	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5,9-12,34,39,40 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5,9-12,34,39 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Request for Continued Examination*

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2009 has been entered.
2. Claims 3-5, 9-12, 34, 39, 40 and 62 are pending.  
Claim 40, drawn to non-elected inventions are withdrawn from examination.  
Claims 9, 11 and 12 have been amended.  
Claims 3-5, 9-12, 34, 39 and 62 are examined on the merits.
3. The Examiner erred in the citation of a reference in the now withdrawn rejection under 35 U.S.C. 103(a). Previously cited U. S. Patent Application Publication number **2003**/0137106 A1 (effective filing date March 9, 2001) should have been Leung et al./ U. S. Patent Application Publication number **2002**/0137106 A1 (effective filing date March 9, 2001).

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Rejections***

***Claim Rejections - 35 USC § 112***

5. The rejection of claims 9-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of Applicants amendments to the claims submitted October 29, 2008.

***Claim Rejections - 35 USC § 102***

6. The rejection of claims 3-5, 9-11, 39 and 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Kovats et al./ U. S. Patent Application Publication number 2003/0003479 A1 (effective filing date April 19, 2001) is withdrawn in light of Applicants' arguments submitted October 29, 2008, see page 6. Applicants noted Kovats establishes the markers listed in Table 1 are biomarkers with significant increases in the levels of expression in cancer-related samples relative to non-cancerous samples, see last paragraph, page 6 of Applicants' Remarks; and Kovats, section 0343, page 35. Markers V, IV and VII are found within Table 1. However, this rejection may be reinstated upon the deletion of the new matter, see pending 35 U.S.C. 112, first paragraph, **NEW MATTER REJECTION.**

***Claim Rejections - 35 USC § 103***

7. The rejection of claims 3-5, 9-12, 34, 39 and 62 under 35 U.S.C. 103(a) as being unpatentable over Kovats et al./ U. S. Patent Application Publication number 2003/0003479 A1 (effective filing date April 19, 2001), and further in view of Leung et al./ U. S. Patent Application Publication number 2002/0137106 A1 (effective filing date March 9, 2001) and Lee/ U.S. Patent 5,650,291 (issued July 22, 1997/ IDS reference AC submitted September 7, 2004) is in light of Applicants' arguments submitted October 29, 2008, see page 6 and set forth in section 5 of this Action. As noted above this rejection may be reinstated upon the deletion of the new matter, see pending 35 U.S.C. 112, first paragraph, **NEW MATTER REJECTION**.

***Maintained Grounds of Rejection***

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. The **NEW MATTER REJECTION** of claims 3-5, 9-12, 34, 39 and 62 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained.

Applicants continue to assert the amendment made to claim 3 to recite "wherein an increase in the levels of one or more of Markers II and III, or a decrease in the levels of one or more of Markers I, IV, V or VII is indicative that the subject has ovarian cancer.", see amendment submitted February 11, 2008. Applicants now points out Example 1 found on page 47, lines 28-31 wherein it is cited

"...peaks at 9.2kD [Marker II], 19.8kD [Marker III], and 60kD showed higher expression levels on average among the specimens from the cancer patients compared to the controls while the remaining peaks demonstrated the inverse expression pattern."

Applicants' claims read on a specific cancer, ovarian cancer, while the support Applicants point out broadly references cancer, essentially any type of cancer. Furthermore, Applicants' claims note there is an increase in one or more of Markers II and III or a decrease in the levels of one or more of Markers I, IV, V or VII. Wherein, the citation notes having three peaks with higher expression and

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not just one Marker or two as set forth in the claims and the citation also includes a third marker, 60kD, which is not of record in the claims. The Examiner also reviewed the corresponding figure and description, Figure 2B and figure description found on page 11, lines 25-29 and does not see support for the cited amendment. The Examiner continues to not find support for the amendment to claim 3 and the rejection is maintained. Applicants are requested to list the page and line numbers within the disclosure that are commensurate with the amendment or delete the new matter.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The Examiner works a flexible schedule, however she can normally be reached between the hours of 7:30 am to 6:30 pm, with alternate Fridays off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alana M. Harris, Ph.D.  
17 December 2009

/Alana M. Harris, Ph.D./

Primary Examiner, Art Unit 1643